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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,995	03/30/2004	John L. Goers	40211.1USC1	6074

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 09/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/813,995

Applicant(s)

GOERS ET AL.

Examiner

Patricia L. Nordmeyer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 12 – 14, 18 and 20 of copending Application No. 09/726,371 to Goers et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combination of elements of the packing element would be obvious from claim limitations presented.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Goers et al. discloses an intermediate sheet of two or more packing chip precursors being separably connected to at least one adjacent chip precursor (Page 5, Claim 1, lines 1 – 4). The precursor comprises one or more sections each of which is foldably attached to at least one other section which upon folding each form a side of the packing chip (Page 5, Claim 1, lines 5 – 7); securing means for securing the sides of the packing chip in a completed shape (Page 6, Claim

13, lines 7 – 8) selected from the group consisting of bonding media or connecting features (Page 5, Claim 1, lines 8 – 11), said shape having a triangle cross section (Page 6, Claim 12, lines 1 – 3). The chip precursor contains one or more apertures on at least one section configured such that the expanded packing chip forms interlocking engagement with portions of adjacent packing chips when employed as packaging (Page 5, Claim 2, lines 1 – 5).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fuss et al. (USPN 5,468,556) in view of Kelly et al. (USPN 5,439,730).

Fuss et al. discloses expanded packing chips (Figures 2 and 4 – 9) formed from chip precursors that are connected to (Figure 12, #78), but able to be separated from, adjacent precursors (Figure 12, #76). The precursor is folded and one end of the strip is attached by an adhesive, bonding media, (Column 2, lines 34 – 36) to the other end of the end to form the expanded packing chip (Column 2, lines 25 – 28). A variety of adhesives, including wettable adhesive (Column 7, lines 53 – 56), or connecting methods, stapling, crimping or riveting (Column 2, lines 39 – 41), may be used to secure the chip in its expanded formation. The method of forming the packing chip includes forming lines of separation between the chips

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(Figure 12), wherein a chip remains connected to the chips adjacent to it (Figure 12, #78), and placing fold lines (Figures 5 and 6, #48) to configure the shape of the final expanded form. The chips are separated from each other prior to folding (Figure 18) and connecting the ends through connecting features (Column 2, lines 39 – 41) or adhesives (Column 3, lines 1 – 4). However Fuss et al. fails to disclose three sections each of which is foldably attached to at least one other section which upon folding form the sides of the packing chip, the chip precursor containing one or more apertures, the packing chip having a triangular cross-section and forming three sections on each chip by creating fold lines between said sections.

Kelly et al. teaches a triangular cross-section with three different sections foldably attached to each other (Figure 16, #70) and formed with fold lines (Column 9, lines 27 – 29) where the sections contain apertures (Figure 16) for the purposes of having a packing chip that resists the migration of the packed article by interlocking with the other chips in the box or bag and has a greater strength and resiliency (Column 2, lines 40 – 44).

Therefore, one of ordinary skill in the art would have recognized that a packing element formed into a shape having a triangular cross section is well known in the art to use in the packaging of an article for shipping or storage to resists the migration of the packed article by interlocking with the other chips in the box or bag as shown by Kelly et al.

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the apertures, serrated edges or mechanical means of

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attachment in Fuss et al. in order a packing chip that resists the migration of the packed article by interlocking with the other chips in the box or bag and has a greater strength and resiliency as taught by Kelly et al.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

*Harold Y. Pyon*  
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1772

9/15/04